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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,926	09/25/2003	Jong-Shing Guo	412551	6530
30954	7590	07/25/2005	EXAMINER	
LATHROP & GAGE LC 2345 GRAND AVENUE SUITE 2800 KANSAS CITY, MO 64108			SASTRI, SATYA B	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/670,926

Applicant(s)

GUO ET AL.

Examiner

Satya B. Sastri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12, 21, 22, 24, 27-40, 46-48 and 55-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-20, 23, 25, 26, 41-45 and 49-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-63 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to application filed on September 25, 2003. *Claims 1-78* are now pending in the application.

2. Applicant's election of species in the reply filed on 5/25/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. It is noted that applicant's response identifies the claims readable on the elected species incorrectly. The claims readable on the elected species are: *1-10, 13-20, 23, 25, 26, 41-45, 49, 50-54*. Other claims are withdrawn from consideration.

4. Before the outstanding rejections are discussed, the following analysis of preamble to claims has been made:

- It is noted here that the preamble in composition claims recites a statement of intended use or purpose, and as a rule does not limit the scope of the claim, since the statements in preamble merely define the context in which the invention operates, *DeGeorge v. Bernier*, 226 USPQ 758,761, n.3 (Fed.Cir. 1985)
- It is the Examiner's opinion that the preamble language does not provide the antecedent basis for terms in the body of the claim.

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- It is the Examiner's opinion that the preamble language is not essential to understand limitations and/or terms in the claim body.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. ***Claim 13*** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Instant claim recites peel strength values without specifying a substrate. It is the examiner's position that the nature of the substrate would influence the values significantly.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

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subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. *Claims 1-10, 13-20, 23, 25, 26, 41-45, 49-54* are rejected under 35 U.S.C. 103(a) as being unpatentable over Takamatsu et al. (US 5,663,241) in view of Phan et al. (US 5,969,032).

Prior art to Takamatsu et al. discloses removable pressure sensitive adhesives comprising microparticles that are the polymerization product of (a) unsaturated monomer having an aldehyde or a ketone group, and (b) a base monomer and crosslinked with polyhydrazides (abstract). The preferred base monomers alkyl (meth)acrylates are those which have 4-14 carbon atoms in the alkyl chain as exemplified in column 5, lines 10 with 2-ethylhexyacrylate as the most preferred species. A variety of carbonyl-containing monomers disclosed include instantly elected species, i.e. diacetone (meth)acrylamide (column 2, lines 5-12). Additionally, the use of (c) polar monomers are disclosed in column 5, lines 50-67 and includes acrylic acid. The adhesive microparticles comprise 0.1 to 10 parts by wt. of carbonyl monomer (a), 75-99.9 parts of base monomer (b) and optionally, 0 to 20 parts by wt. of polar monomer. Polyfunctional hydrazides may be used as crosslinking agents in amounts of 0.5 to 150 milliequivalents per 100 g of the microparticle with adipoyl dihydrazide as the preferred species (column 7, lines 25-40). Hollow microparticles are disclosed as being derived from all three comonomers in the presence of anionic emulsifiers (column 8, lines 56-64).

The difference between the prior art and the present invention is that the prior art does not teach the use of polymerizable surfactants and the resultant crosslinked particle size in the adhesive composition.

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The primary reference discloses the use of emulsifiers, albeit of a different nature. Secondary reference to Phan et al. discloses the use of an allyl amine salt of alkyl benzene sulfonate with allyl amine salt of dodecylbenzene sulfonate as the preferred species for polymerization of acrylic latexes in amounts ranging from 0.1 to 5% by wt., based on the total monomer content (column 5, lines 14-29, 60-67). Polymerization is typically conducted between a pH of 2-7 (abstract) and result in polymers having an average particle diameter of less than 500 nm (column 7, lines 46-50 and working examples). The use of surfactants disclosed in this prior art allows lower levels of polymerizable surfactants to control the latex particle size and to stabilize the latex particles (abstract). In light of such motivation, it would have been obvious for one of ordinary skill in the art at the time the invention was made to include with allyl amine salt of dodecylbenzene sulfonate as the polymerizable surfactant for polymerization of acrylic latexes of Takamatsu et al. and thereby obtain the present invention.

With regard to *claim 13*, given that the instant claims read on the combined references disclosed above, it is the examiner's position the resultant adhesive must intrinsically possess the claimed peel strength value.

### ***Conclusion***

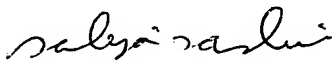
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 272 1112.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 272 1114.

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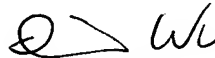
The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SATYA SASTRI

July 19, 2005



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